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GIFFORD, KRASS, GROH, SPRINKLE
ANDERSON & CITKOWSKI, PC
280 N OLD WOODARD AVE
SUITE 400
BIRMINGHAM, MI 48009

EXAMINER

GREEN, BRIAN

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,522

Applicant(s)

YU ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 8, 9 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 10, 11 and 13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Species I. Figs. 1 and 2;

Species II. Figs. 3 and 4;

Species III. Figs. 5A and 5B.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 11 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Avery Goldstein on Oct. 27, 2004 a provisional election was made without traverse to prosecute the invention of Species II. (figures 3 and 4), claims 1-3,7,10,11, and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-6,8,9, and 12 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fold line in the figures 3 and 4 embodiment as defined in claims 3 and 11, the third ink have a color different than the second ink defined in claim 10, and the package and pen defined in claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to indicate that the card further includes a third ink having a color different than the second ink as defined in claim 10.

Claim Objections

Claim 7 is objected to because of the following informalities: In claim 7, line 1, “said securement” should be “a securement” since there is no antecedent basis for “said securement”. It appears that claim 7 should depend on claim 2 since the applicant defines the securement in claim 2. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon et al. (US 2003/0025316) in view of Ristow et al. (U.S. Patent No. 1,861,136) and Funk et al. (U.S. Patent No. 6,269,169).

Solomon et al. shows in figures 1-3 a sheet that includes indicia readable under light having a wavelength of between 350 and 400 nanometers, see paragraph [0015], and an ultraviolet light source/flashlight (see figures 3). Solomon et al. discloses that the sheet maybe in the form of stationery, see paragraph [0021]. Solomon et al. does not disclose whether a first ink readable under visible light is provided on the stationery and the use of a light emitting diode as the light source. Ristow et al. shows in figures 1-3 a stationery article in the form of a greeting card that includes a first ink (the pictures and words in figures 1 and 3) readable under visible light. In view of the teachings of Ristow et al. it would have been obvious to one in the art to modify Solomon et al. by placing a first ink readable under visible light onto the stationery/greeting card since this would make the stationery/greeting card more aesthetically pleasing and would allow a desired message to be conveyed to all viewers of the stationery/greeting card. Funk et al. discloses in column 4, lines 54-55 the idea of using light emitting diodes as a ultraviolet light source. In view of the teachings of Funk et al. it would have been obvious to one in the art to modify Solomon et al. by making the light source in the form of an LED since this would reduce

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the amount of heat generated by the light source, reduce the energy required to power the light source, and would allow the light source to last a lot longer. In regard to claim 3, Ristow et al. shows in figure 3 the idea of placing a fold line (7,8) on the sheet of stationery/greeting card. In view of the teachings of Ristow et al. it would have been obvious to one in the art to modify Solomon et al. by placing a fold line in the sheet since this would allow the card to be made into the form of a greeting card to allow more information to be conveyed in a more aesthetically pleasing manner. In regard to claim 10, the examiner takes official notice that it is known to write messages in different colors, i.e. the examiner has been writing messages in birthday cards with a color marker which is different than the color of the pre-printed indicia (generally black) located in the card for the past 14 years. It would have been obvious to one in the art to modify Solomon et al. by placing a third ink having a color different than the second ink color since this would create a more amusing and aesthetically pleasing display.

Claims 2,7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon et al. (US 2003/0025316) in view of Ristow et al. (U.S. Patent No. 1,861,136) and Funk et al. (U.S. Patent No. 6,269,169) as applied to claim 1 above and further in view of Prescott et al. (U.S. Patent No. 6,805,459).

Solomon et al. in view of Ristow et al. and Funk et al. disclose the applicant's basic inventive concept except for providing a securement to retain the ultraviolet light flashlight. Prescott et al. shows in figures 1-4 a light source (20) that is attached to a book for reading purposes. Prescott et al. discloses in column 6, lines 25-30 the idea of releasably attaching the light source to the book with a hook and loop securement device. In view of the teachings of Prescott et al. it

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would have been obvious to one in the art to modify Solomon et al. by using a securement device to attach the light source/flashlight to the stationery since this would allow the light source/flashlight to be attached to the stationery in an easier and more convenient manner. In regard to claim 11, Ristow et al. shows in figure 3 the idea of placing a fold line (7,8) on the sheet of stationery/greeting card. In view of the teachings of Ristow et al. it would have been obvious to one in the art to modify Solomon et al. by placing a fold line in the sheet since this would allow the card to be made into the form of a greeting card to allow more information to be conveyed in a more aesthetically pleasing manner.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon et al. (US 2003/0025316) in view of Ristow et al. (U.S. Patent No. 1,861,136) and Funk et al. (U.S. Patent No. 6,269,169) as applied to claim 1 above and further in view of Heinze III. (U.S. Patent No. 6,047,820).

Solomon et al. in view of Ristow et al. and Funk et al. disclose the applicant's basic inventive concept except for providing a package and instructions for writing with the pen on the greeting card. Heinze III. shows in figures 1-3 a package that includes a greeting card and instructions on how to use the contents of the package. In view of the teachings of Heinze III. it would have been obvious to one in the art to modify Solomon et al. by providing a package and instructions since this would allow the stationery, pen, and light source to be combined together for sale or storage in a more convenient manner and would allow the method of use of the contents of the package to be clearly conveyed to purchasers/owners of the package.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nelson, Hagopian, and GB 2,204,981 teach the use of displays that use ultraviolet light. Franc teaches the use of a light source attached to a greeting card. Alonso teaches the use of card that has invisible indicia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Nov. 10, 2004